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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/240,456

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-48 are presented for examination.
2. Applicant's IDS submitted on 02/14/01 and 06/27/02 has been reviewed and considered.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed in addition to any changes by the draftsman in paper no. 1 submitted with this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,794,221) Egendorf.

As a preliminary matter, the Examiner notes that the term "patent and trademark fees" will not be given any patentable weight in the independent claims 1, 10, 15, 17, and 24 since the terms are only found in the preamble. The preamble is not given the effect of a limitation unless it breathes life and meaning by the claim (see MPEP Section 2111.02). The terms "patent and trademark fees" merely describes the purpose of the claimed method.

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As to claim 1, Egendorf discloses a computerized method for managing fees (see abstract) comprising:

inputting identification information for a matter of a client of a firm (i.e. customer) and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer workstation (i.e. vendors 8.1 who are connected directly to the Internet via access network 7 and provider 9 to bill customers 4.1 for services purchased by them over the Internet. The exchange of information may include identifying information relating to the customer relating to the products or services being purchased) (col. 4, lines 57-col. 5, line 7 and lines 18-27).

issuing a charge for the requested fee at the computer workstation for transmittal to the agency, the charge payable against an account maintained by an organization (i.e. bank) separate from the firm for the client, the account (i.e. bank account or credit card) initially funded by the client such that the account has a positive balance (i.e. vendors 8.1 who are connected to the Internet 1 via access network 7 and provider 9, to bill customers for the goods and services purchased. The billing will be done to billing accounts established in connection with the agreement (bank accounts, credit card accounts, etc.) (col. 4, lines 61-64 and col. 5, lines 3-7).

Egendorf did not specifically teach, generating a client (i.e. customer) invoice (i.e. bill) including the charge for the requested fee to replenish the account maintained by the organization (i.e. bank or credit card company) so that upon payment by the client (customer) the account continually retains a positive balance. However Egendorf does teach generating a customer bill including a requested fee (the provider bills the

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transaction amount to a customer billing account and remits a portion of the transaction amount to the vendor (col. 2, lines 25-27) (the customer has agreed on a method of payment (which is assumed to include any fees) which could be a charge or credit card or a bank account) (col. 2, lines 59-65). However, the Examiner takes official notice that it is well known in the art of bill paying and fee collection to replenish the account so that upon payment by the customer the account continually retains a positive balance. This allows for the account to not be charge additional fees or charges and to maintain a balance of equality of a control account in the general ledger (e.g. accounts receivable) and the total balance of all accounts in the subsidiary ledger (e.g. customer accounts).

It would have been obvious to one having ordinary skill in the art at the time of Applicants' invention to include the method steps 1 and 2, generating a client invoice including the charge for the requested fee to replenish the account maintained by the organization so that upon payment by the client the account continually retains a positive balance within the Egendorf system in order to allow the customer's bank account not to become over drawn and incur additional fees.

6. Claims 2-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,794,221) Egendorf in view of (US 5,649,117) Landry.

As to claim 2, Egendorf teaches, receiving notice of an event for the matter of the client of the firm that will require a second fee associated with the matter for payment to the agency by a due date (a remitting agreement usually contains a date when the payment is due from the customer) (col. 5, lines 43-60).

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Egendorf did not teach, generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee.

Landry discloses, generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee (col. 5, lines 12-21 and col. 6, lines 32-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Egendorf's receiving notice of an event for the matter of the client of the firm that will require a second fee associated with the matter for payment to the agency by a due date with Landry's generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee because such a combination would allow have a simplified accounting system for a number of transactions which can be reported in periodic statements of accounts and to have a positive account maintained by the customer.

As to claims 3 and 18, Egendorf and Landry did not teach, wherein the charge included on the second client invoice for the requested fee is less than the requested fee, the account having a positive balance less than the requested fee. However, the Examiner takes official notice that it is well known in the art of billing and fee collection to have the charge included on the second invoice (bill) for the requested fee to be less

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than the requested fee with the account having a positive balance less than the requested fee. The purpose of the second invoice (bill) for the requested fee to be less than the original requested fee would only be obvious that if the bill is for a lesser requested fee than the originally requested fee the account to would have a positive balance since the originally requested fee is less than the balance in the account. It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the charge included on the second client invoice for the requested fee is less than the requested fee, the account having a positive balance less than the requested fee within the Egendorf and Landry systems for the motivation stated above, *supra*.

As to claims 4 and 19, Egendorf did not teach, wherein generating the second client invoice comprises generating the second client invoice at an accounting computer system of the firm.

Landry discloses, wherein generating the second client invoice comprises generating the second client invoice at an accounting computer system of the firm (col. 5, lines 44-49). It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to generate the second client invoice comprising the second client invoice at an accounting computer system of the firm and to include in Egendorf because an accounting system includes the formal records and original data maintained by a company (firm).

As to claims 5 and 20, Egendorf teaches, generating the charge for the requested fee at a fee computer system of the organization (col. 6, lines 13-35);

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transmitting data regarding the charge from the fee computer system to an accounting computer system of the firm (col. 5, lines 18-35); and generating the second client invoice at the accounting computer system (col. 4, lines 57-65).

As to claims 6 and 21, Egendorf teaches, wherein receiving notice of the event at an accounting computer system of the firm (col. 4, lines 65-67 and col. 5, lines 1-3) and transmitting data regarding the event from the accounting computer system to a fee computer system of the organization (col. 5, lines 3-10 and lines 31-42).

As per claims 7 and 23, Egendorf teaches, further comprising tracking a payment made by the client as covering one of an already made charge for a requested fee associated with a matter for payment to the agency and a charge to be made for a requested fee associated with a matter for payment to the agency (col. 5, lines 43-56).

As per claims 8 and 24, Egendorf and Landry did not teach, further comprising issuing a refund to the client for regular payment made thereby for charges to be made requested fees associated with a matter for payment to the agency. However, the Examiner takes official notice that it is well known in the art to issue a refund to the client for regular payment made for charges to be made to requested fees associated with a payment to an agency. The purpose of the refund to the customer for regular payment for charged for the requested fees is when an over payment is made or when the customer paid the bill in a timely manner. It would have been obvious to one having ordinary skill in the art at the time the Applicant's invention was made to include the method of claims 8 and 24, comprising a refund to the client for regular payment made thereby for charges to be made requested fees associated with a matter for payment to

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the agency within the Egendorf and Landry systems for the motivation stated above, *supra*.

As per claims 9, 25, 37, and 44, Egendorf teaches, wherein payment made by the client comprises a charging of one of a credit card and a charge card of the client (col. 6, lines 23-28).

As per claims 10, 26, 38, and 45, Egendorf teaches, wherein the charging is automatic (col. 6, lines 28-32).

As per claims 11, 27, 39, and 46, Egendorf teaches, wherein the one of the credit card and the charge card comprises one of a Visa card, a MasterCard card, an American Express card, an Optima card and a Discover card (i. e. the customer can indicate the account by the "brand" name) (col. 6, lines 32-36).

As per claims 12, 28, 40, and 47, Egendorf teaches, wherein the one of the credit card and the charge card of the client is sponsored by the organization (col. 6, lines 37-40).

As per claims 13, 29, 41, and 48, Egendorf teaches, wherein the one of the credit card and the charge card of the client is issued by the organization (col. 6, lines 37-51).

As per claim 14, Egendorf and Landry did not teach, computing interest on a positive balance of the account to be paid to the client; determining whether on average the account has a positive balance; and upon determining that on average the account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency. However, the Examiner takes official notice that it is

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well known in the billing arts to compute interest on a positive balance of an account to be paid to the client, to determine whether on average the account has a positive balance, and determining that on the average the account has a positive balance, providing no cost issuance of the charge for the requested fee for transmittal to the agency are all accounting functions used in an organization in the reconciling of accounts. It would have been obvious to one having ordinary skill in the art at the time the Applicant's invention was made to include the computerized method of claim 1, computing interest on a positive balance of the account to be paid to the client; determining whether on average the account has a positive balance; and upon determining that on average the account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency within the Egendorf and Landry systems for the motivation stated above, *supra*.

As per claim 15, Egendorf teaches, transmitting electronically data representing first information regarding the charge for the requested fee from the computer workstation to a fee computer system maintained by the organization (col. 5, lines 18-35); inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system (i.e. provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved) (col. 5, lines 35-37); and reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer (i.e.

provider 2 can then send verifying information to one or both of the customer and vendor to indicate the transaction has been approved) (col. 5, lines 35-37).

As per claim 16, Egendorf teaches, generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting system maintained by the firm (col. 4, lines 52-67); generating a firm invoice including the charge at the fee computer system for delivery to the firm (col. 5, lines 43-56). Egendorf and Landry did not teach, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. However, the Examiner takes official notice that it is well known in the art of electronic billing to have the client invoice correspond to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. The purpose is to emulate traditional billing and to provide convenient and correct billing to customers. It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 1, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice within the Egendorf and Landry systems for the motivation stated above, *supra*.

As per claim 17, Egendorf teaches, generating a client invoice including a charge for the requested fee to pre-fund the account maintained by an organization separate from the firm such that upon payment by the client of the client invoice prior to

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the due date the account has a sufficient positive balance to cover the second fee (col. 6, lines 4-36).

This independent claim is also rejected for the similar rationale given for claim 2, *supra*.

As per claim 22, this dependent claim is rejected for the similar rationale given for claim 14, *supra*.

As per claim 30, this dependent claim is rejected for the similar rationale given for claims 7-29, *supra*.

As per claim 31, this dependent claim is rejected for the similar rationale given for claims 8 and 23, *supra*.

As per claim 32, this dependent claim is rejected for the similar rationale given for claims 1 and 15, *supra*.

As per claim 33, this dependent claim is rejected for the similar rationale given for claim 16, *supra*.

As per claim 34, Egendorf teaches, wherein generating data representing a fee invoice comprises assigning a unique tracking number for each charge issued by the organization to the agency for the client of the firm (col. 2, lines 10-36).

As per claim 35, Egendorf teaches, wherein generating the client invoice comprises including the unique tracking number for each charge issued on the client invoice, and generating the firm invoice comprises including the unique tracking number (col. 2, lines 38-50).

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As per claim 36, Egendorf and Landry did not teach, further comprising matching payments made by the client with the unique tracking numbers for the charges issued by the organization to the agency for the client to determine whether a given charge was prepaid by the client. However the Examiner takes official notice that it is well known in the billing art to match payments made by the client with the unique tracking numbers for the charges issued by the organization to the agency for the client to determine whether a given charge was prepaid by the client. The purpose of using unique tracking numbers for the charges issued by the organization is because it is easier to keep records for a client by using the tracking numbers unique to a particular client for billing and fee collection purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the computerized system of claim 30, comprising matching payments made by the client with the unique tracking numbers for the charges issued by the organization to the agency for the client to determine whether a given charge was prepaid by the client. However the Examiner takes official notice that it is well known in the billing art to match payments made by the client with the unique tracking numbers for the charges issued by the organization to the agency for the client to determine whether a given charge was prepaid by the client within the Egendorf and Landry systems for the motivation stated above, *supra*.

A per claim 42, Egendorf teaches, payment to a vendor (col. 2, lines 58-65).

This independent claim is rejected for the similar rationale given for claims 15 and 32, *supra*.

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As per claim 43, Egendorf teaches, generating a client invoice including the fee invoice at the accounting computer system for delivery to the client (col. 4, lines 57-67).

This dependent claim is rejected for the similar rationale given for claim 16, *supra*.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Google Groups, discloses plus and minus accounting software from Taylon .

Reeder (US 5,85,812) discloses a billing system for on-line computer networks.

Knolling et al (US 5,920,847) discloses an electronic bill pay system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read "E. Colbert", with a long horizontal flourish extending to the right.

E. Colbert

October 1, 2002